B. REMARKS

The Examiner is thanked for the performance of a thorough search. By this amendment, Claims 1, 8, 19, 26 and 37-40 have been amended. Hence, Claims 1-41 are pending in this application. The amendments to the claims do not add any new matter to this application and were made to improve the readability and clarity of the claims. All issues raised in the Office Action mailed August 26, 2004 are addressed hereinafter.

REJECTION OF CLAIMS 1 AND 19 UNDER 35 U.S.C. § 101

Claims 1 and 19 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. The basis for the rejection is that "[t]he recitations in at least the claims 1 and 19 are directed to merely human mental computation and/or processes that can be performed by a person manually, and thus is considered nothing more than an abstract idea which is not useful art as contemplated by the constitution." Furthermore, the Office Action mentions that "[t]he abstract idea does not become a technological art by reciting in the preamble, for example, 'a computer-implemented method...'".

Claims 1, 19, 37 and 38 have been amended herein to recite that the determining of the amount to be billed to the customer is performed in a computer system. It is therefore respectfully submitted that the claims more clearly recite technology and are "tied to a technological art," as suggested in the Office Action. In view of the foregoing, reconsideration and withdrawal of the rejection of Claims 1 and 19 under 35 U.S.C. § 101 is respectfully requested.

REJECTION OF CLAIMS 1-41 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-41 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The basis for the rejection is that (1) the use of the term "may be" is indefinite in the limitation "may be dynamically selected and de-selected"; (2) the meaning of the term "dynamically" is unclear; (3) the difference between the "usage data" and the "value data" recited in the claims is unclear; and (4) the use of the term "baseline" is unclear.

The claims have been amended to address items 1, 2 and 4. Specifically, the term "may be dynamically" has been replaced with "is capable of being". Also, the term "baseline" has been replaced with "initial." With regard to the difference between "usage data" and "value data", it is respectfully submitted that the claims as filed clearly recite the differences. Namely, usage data "indicates usage, during a specified period of time, of a set of one or more resources," while value data "indicates value provided by each resource from the set of one or more resources."

In view of the foregoing, it is respectfully submitted that the rejection of Claims 1-41 under 35 U.S.C. § 112, second paragraph, has been fully addressed and reconsideration and withdrawal of this rejection is respectfully requested.

REJECTION OF CLAIMS 1-41 UNDER 35 U.S.C. § 103(a)

Claims 1-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Crooks et al.*, U.S. Patent No. 5,930,773 (hereinafter "*Crooks*"). It is respectfully submitted that Claims 1-41 are patentable over *Crooks* for at least the reasons provided hereinafter.

CLAIM 1

Claim 1, as amended, recites a method for determining an amount to be billed to a customer for the use of resources. The method requires:

> "determining usage data that indicates usage, during a specified period of time, of a set of one or more resources that is capable of being selected and de-selected from a plurality of resources; and
> in a computer system determining the amount to be billed to the customer based upon the usage data and value data that indicates value provided by each resource from the set of one or more resources."

It is respectfully submitted that Claim 1 includes one or more limitations that are not taught or suggested by *Crooks*. For example, Claim 1 requires "determining usage data that indicates usage, during a specified period of time, of a set of one or more resources that is capable of being selected and de-selected from a plurality of resources." *Crooks* describes a utility resource management system that receives resource usage information that indicates consumption of resources by customers. The utility resource management system processes the resource usage information and generates computer-viewable data that indicates a customer's consumption of one or more resources. The computer-viewable data may be accessed by customers through interface devices and presented in different forms, for example, in graphical, numerical or tabulated reports.

There is no teaching or suggestion in *Crooks* that the described resources are "capable of being selected and de-selected form a plurality of resources" as is required by Claim 1. In *Crooks*, the resources are described as static resources, for example, utilities. It is therefore respectfully submitted that the Claim 1 limitation of "determining usage data that indicates usage, during a specified period of time, of a set of one or more resources that is capable of being selected and de-selected from a plurality of resources" is not taught or suggested by *Crooks*.

Notwithstanding the foregoing, even if the resources described in *Crooks* satisfied the requirements of Claim 1, the additional Claim 1 limitation of "in a computer system determining the amount to be billed to the customer based upon the usage data and value data that indicates value provided by each resource from the set of one or more resources" is not in any way taught or suggested by *Crooks*. The utility resource management system of *Crooks* tracks consumption of resources by consumers and describes storing and processing historical billing data to determine tolerance parameters for resource providers. There is no description or suggestion of determining amounts to be billed to customers. Furthermore, there is no teaching or suggestion in *Crooks* of determining amounts to be billed to customers "based upon the usage data and value data that indicates value provided by each resource from the set of one or more resources," as is required by Claim 1.

The Office Action asserts that the "determining" limitation recited in Claim 1 is taught by *Crooks* at Col. 16, lines 54+ and FIGS. 37, 38A and 38B. These figures and the text at Col. 16, lines 54+ of *Crooks* describe providing a graphical representation, in the form of a scatter plot graph, of an energy use index (EUI) and an energy cost index (ECI), which portray the energy use and cost performance characteristics of facilities or sites, given that different fuel types vary in terms of conversion efficiency and cost. This portion of *Crooks* and the accompanying figures do not in any way teach or suggest the value provided by resources or determining amounts to be billed to customers "based upon the usage data and value data that indicates value provided by each resource from the set of one or more resources." It is therefore respectfully submitted that the Claim 1 limitation of "in a computer system determining the amount to be billed to the customer based upon the usage data and value data that indicates value provided by each

resource from the set of one or more resources" is also not in any way taught or suggested by *Crooks*.

In view of the foregoing, it is respectfully submitted that Claim 1 recites one or more limitations that are not in any way taught or suggested by *Crooks* and that Claim 1 is therefore patentable over *Crooks*.

CLAIMS 2-18

Claims 2-18 all depend from Claim 1 and include all of the limitations of Claim 1. It is therefore respectfully submitted that Claims 2-18 are patentable over *Crooks* for at least the reasons set forth herein with respect to Claim 1. Furthermore, it is respectfully submitted that Claims 2-18 recite additional limitations that independently render them patentable over *Crooks*.

For example, Claim 5 further requires that "determining the amount to be billed to the customer based upon the usage data and value data includes determining the amount to be billed to the customer based upon the usage data, the value data and a reservation fee for reserving the set of one or more resources." There is no mention or suggestion in *Crooks* of a reservation fee for reserving a set of one or more resources. Furthermore, there is no teaching or suggestion in *Crooks* of determining an amount to be billed to a customer based upon a reservation fee for reserving the set of one or more resources. It is therefore respectfully submitted that the additional limitations recited in Claim 5 are not in any way taught or suggested by *Crooks*.

As another example, Claim 9 further requires "wherein the set of one or more resources comprise a virtual server farm." There is no mention or suggestion in *Crooks* of virtual server farms (VSFs). The Office Action asserted that this limitation is taught by *Crooks* at FIGS. 3 and 4 and the text at Col. 7, lines 10-22, Col. 8, lines 36+, Col. 8, lines 58+ and Col. 9, lines 29+. There is no teaching or suggestion in these figures or portions of *Crooks* that the resources are

VSFs. In fact, a text-based search of *Crooks* reveals that the terms "virtual", "server", "farm" and "VSF" are completely absent from *Crooks*. It is therefore respectfully submitted that the additional limitations recited in Claim 9 are not in any way taught or suggested by *Crooks*.

The other dependent claims also contain limitations that independently render them patentable over *Crooks*, but these claims are not discussed herein for purposes of brevity only.

CLAIMS 19-36

Claims 19-36 recite limitations similar to Claim 1-18, except in the context of computer-readable media. It is therefore respectfully submitted that Claims 19-36 are patentable over *Crooks* for at least the reasons set forth herein with respect to Claims 1-18.

CLAIMS 37 AND 38

Claim 37 recites limitations similar to Claim 1. It is therefore respectfully submitted that Claim 37 is patentable over *Crooks* for at least the reasons set forth herein with respect to Claim 1. Claim 38 recites limitations similar to Claim 37, except in the context of a computer-readable medium.

CLAIMS 39-41

Claims 39-41 recite limitations similar to Claim 1, except in the context of apparatuses. It is therefore respectfully submitted that Claims 39-41 are patentable over *Crooks* for at least the reasons set forth herein with respect to Claim 1.

In view of the foregoing, it is respectfully submitted that Claims 1-41 are patentable over *Crooks*. Accordingly, reconsideration and withdrawal of the rejection of Claims 1-41 under 35 U.S.C. § 103(a) as being unpatentable over *Crooks* is respectfully requested.

CONCLUSION

It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

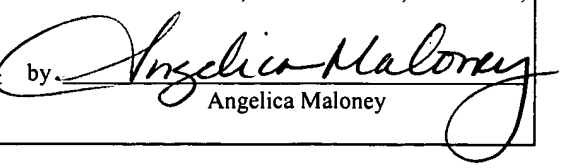
HICKMAN PALERMO TRUONG & BECKER LLP

Edward A. Becker
Reg. No. 37,777
Date: October 28, 2004

1600 Willow Street
San Jose, CA 95125
(408) 414-1204
Facsimile: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop Amendment**, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

on October 28, 2004 by 

Angelica Maloney